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Response following RCE filed on May 26, 2006

Remarks

The Applicant appreciates the Examiner's continued consideration of the present Application, and especially appreciates the Examiner's time during the in-person Examiner's Interview that was conducted on June 5, 2006 at the Patent Office. In view of that Interview, as well as in view of the final Office action mailed on April 6, 2006 and the Request for Continued Examination that was submitted to the Patent Office on May 26, 2006, the Applicant is submitting the present Amendment.

In the final Office action mailed on April 6, 2006, responses to the arguments presented by the Applicant in the previous Amendment mailed on January 3, 2006 were provided. Additionally, all of pending claim 24-43 were rejected and claim 34 additionally was objected to due to a word processing error. More particularly with respect to the claim rejections, claim 24 was rejected under 35 U.S.C. 112 for indefiniteness apparently due to its use of the language "potentially desired" and/or "potentially available". Additionally, claims 31 and 32 were rejected under 35 U.S.C. 112 apparently because of their use of the term "third information" and claims 42 and 43 were rejected under 35 U.S.C. 112 apparently because the claims referred to first through fifth parties. Also, claims 24-27 and 32-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (U.S. Patent No. 5,892,900). Further, claims 28-31 as well as claims 35-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. in view of plx (The Patent and License Exchange FAQ sheet, copyright 1999).

In view of the discussions during the June 5th Examiner's Interview, as well as the April 6th Office action, the Applicant has again made changes to the claims in an effort to advance the prosecution of the present Application. More particularly, as shown above, claims 24-34, 37, 40, and 42-43 have been cancelled, claims 35, 36 and 38 have been amended, and new claims 44-58 have been added (with the total number of claims as well as the total number of independent claims remaining the same as before). Due to these amendments, claims 35, 36, 38, 39, 41 and 44-58 are pending in the application, with claims 35, 44 and 56 now being the independent claims.

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To facilitate the Examiner's understanding of the amended claim set, the Applicant provides discussion below regarding the changes to the claims that have been made. The Applicant appreciates the Examiner's consideration of this modified claim set and respectfully submits that the modifications to the claims have not been made to confuse the Examiner but rather have been made to further improve the claim language, particularly in view of the issues raised during the Examiner's Interview. The Applicant would be pleased to discuss with the Examiner any questions the Examiner has with respect to the amended claim set, and respectfully requests that the Examiner telephone the Applicant at the telephone number listed below if discussion would be helpful.

Further, the Applicant also provides discussion below as to why the Applicant believes that the amended claims now are in condition for allowance, and more particularly as to why the rejections and objection raised in the Office action of April 6th are no longer applicable.

Amendments to the Claims

As noted above, previously pending claims 24-34, 37, 40 and 42-43 have all been cancelled. It should in particular be noted that previously-pending independent claim 43 has been cancelled.

Additionally, certain minor amendments have been made to claims 35, 36, and 38. With respect to independent claim 35 in particular, the Applicant has deleted the phrase "onto the internet" to broaden the claim to encompass situations in which the proposed agreement is provided by way of some other medium or in some other manner than by way of the internet. Notwithstanding this deletion, claim 35 still requires use of the internet in another step of the claim, and also claim 36 has been amended to require that the proposed agreement be provided onto the internet as well. Further with respect to claim 35, the Applicant has added language to clarify that the proposed agreement is provided by the first party rather than by some other party, and that it is either the proposed agreement or a modified version thereof that is concluded. The latter change is intended to broaden the claim language to allow for the possibility that the agreement that is finally executed may differ from the originally proposed agreement somewhat (e.g., if a counteroffer is made by the recipient of the proposed agreement, or some negotiation

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occurs between the parties subsequent to the time at which the proposed agreement is initially provided). The amendments to claim 38 have been made to further clarify various types of evaluations that can be made.

Further, new independent claims 44 and 56 have been added, each of which is largely but not entirely the same as cancelled independent claim 24. In particular, it will be noted that the language of claim 44 substantially follows the language of previously-pending claim 24 except insofar as certain changes have been made to steps (b), (c) and (e). Step (b) now clarifies that the processing involves an evaluation that is more involved than simply the selection of a bid price (albeit the processing could in some embodiments eventually result in the determination of a price). The terms "potentially desired" and "potentially available" have been eliminated and instead replaced merely with the terms "desirable" and "available", respectively. Also, similar to the amendments described above with respect to claim 35, step (d) of claim 44 differs from that of cancelled claim 24 in that there is no longer any requirement that the proposed agreement be provided by way of the internet, and step (e) of claim 44 differs from that of cancelled claim 24 in that the claim language now allows for the possibility that the actual agreement that is executed between the parties is not the original proposed version of the agreement but rather is a modified version of the agreement.

As for new independent claim 56, this claim is a further modified version of cancelled claim 24 that includes a similar version of step (e) as exists in new claim 44 (albeit, in contrast to claim 44, claim 56 still requires in step (d) that the proposed agreement be provided onto the internet). In contrast to claim 44, however, claim 56 is specifically directed to circumstances in which the first party is acquiring an interest in an intellectual property asset rather than to either acquiring or disposing of an interest in an intellectual property asset as is the case with claim 44. Also, step (b) of claim 56, in contrast to step (b) of claim 44, requires that a valuation analysis be performed to ascertain a value of the intellectual property asset.

As for the new dependent claims 45-55 and 57-58, claims 45-48 generally elaborate on types of evaluations that can be done in accordance with step (b) of claim 44 when the situation is one in which the transfer of the interest in the intellectual property interest is from the second party to the first party. Likewise, claim 57 generally

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elaborates on types of valuation analyses that can be done in accordance with step (b) of claim 56. Dependent claim 50 by contrast generally elaborates on types of evaluations that can be done in accordance with step (b) of claim 44 when the situation is one in which the first party is attempting to transfer an intellectual property asset to the second party.

Further, each of dependent claims 49 and 58 generally recites steps that can be followed when, subsequent to the transfer of the interest in the intellectual property asset from the second party to the first party, that interest (or another interest, e.g., a subset of that interest) is in turn additionally transferred to a third party. Claims 49 and 58 largely follow cancelled claim 33. By contrast, dependent claim 51 generally recites steps that can be followed when, prior to the transfer of the interest in the intellectual property asset from the first party to the second party, that interest (or another interest, e.g., a larger interest) is first transferred to the first party from a third party. In contrast to the language of step (d) of claim 44, claims 49 and 51 also specify that the proposed agreements be provided onto the internet. Additionally, dependent claims 52-55 largely follow cancelled claims 28-32 with claim 55 being a combination of cancelled claims 31 and 32. Further, like amended claim 35, new claim 52 specifies that the proposed agreement is provided by the first party.

The Applicant believes that the modifications to the claims have not added new matter to the present Application. In particular, the language of claims 44 and 56 regarding the performing of processing to evaluate the desirability or availability of an intellectual property asset and valuation analysis is supported in the Specification at, for example, page 22, lines 11-21, and on page 25, lines 16-25. Valuation as described in the aforementioned passages of the Specification involves more than merely selection or identification of a price, but involves consideration or analysis such as an analysis of the value of the patent based upon the technology it covers (see, e.g., lines 19-21 of page 25).

Allowability of the Claims

The Applicant respectfully submits that pending claims 35, 36, 38-39, 41 and 44-58 are in condition for allowance, and that the rejections and objection raised in the April 6th Office action either are overcome or are no longer pertinent. The Applicant addresses

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each of the objection and rejections raised in the Office action below, to the extent that it appears appropriate to do so in view of the changes to the claims discussed above.

In considering the Applicant's discussion below, the Applicant also requests that the Examiner recall the discussion during the June 5th Examiner's Interview concerning how claim language should be interpreted, and in particular that claims are to be given their "broadest reasonable interpretation consistent with the specification" *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000) (emphasis added). For further reference in this regard, the Applicant respectfully directs the Examiner's attention to an article in the March, 2006 edition of the Journal of the Patent and Trademark Office Society (Volume 88, Number 3) entitled "Claim Construction at the PTO – The 'Broadest Reasonable Interpretation...'"

Objection to Claim 34

The Applicant appreciates the Examiner's careful consideration of the claims and the observation that previously-pending claim 34 redundantly mentioned the term "trademark" twice. In view of the cancellation of claim 34, the objection to that claim is now moot. Additionally, to the extent that currently pending claim 47 largely recites the language of cancelled claim 34, the Applicant has corrected the language of the claim.

Rejections Under 35 U.S.C. 112

The specific rejections of claims 24, 31, 32, 42 and 43 under 35 U.S.C. 112 now are moot in view of the cancellation of each of those claims.

Further, to improve the clarity and focus of the presently-pending set of claims, the language of cancelled independent claim 43 and dependent claim 42 has not been repeated in any of the new claims. Thus, there should no longer be any confusion regarding any first through fifth parties as were recited in cancelled claims 42-43.

As for the language regarding "third information" in cancelled claims 31 and 32, similar language is now found in new claims 49, 51 and 58. Notwithstanding the comments in the April 6th Office action regarding this language, the Applicant respectfully submits that this language is indeed sufficiently clear so as to not be indefinite. More particularly, the reason that the term "third information" is used in these

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claims is to account for the possibility that the information provided from a third party to the first party concerning the nature of the intellectual property asset being transferred may not be identical to the information that is provided from the second party to the first party concerning that intellectual property. For example, while the second party might provide a patent number to the first party when the second party is in the process of selling a patent to the first party, later on a third party might provide a title (rather than a patent number) of that patent to the first party when attempting to acquire the patent from the first party.

Finally, with respect to the language "potentially desired" and "potentially available" as used in cancelled claim 24, new independent claims 44 and 56 do not use this language but rather use the language "desirable" and/or "available" without the use of the word "potentially". The Applicant respectfully submits that this language is clear on its face and also finds support in the Specification of the Application (*see, e.g.*, page 23, lines 5-8 of the Specification). It should be added further that, although the Applicant believes that the present language of claims 44 and 56 is not indefinite, the Applicant would be pleased to discuss with the Examiner any alternative language that the Examiner might feel to be an improvement.

Rejections Under 35 U.S.C. 103(a) in View of Ginter et al. and Plx

In the April 6th Office action, claims 28-31 as well as claims 35-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. in view of plx. As discussed above, claims 35, 36, 38, 39 and 41 remain pending. Of these, claims 35, 36 and 38 have been amended as discussed above. Additionally, as mentioned above, new claims 52-55 largely follow previously-pending claims 28-32 (with claim 55 being based upon both of claims 31 and 32). Notwithstanding the comments in the April 6th Office action regarding claims 35-41 and 28-31, the Applicant respectfully submits that all of pending claims 35, 36, 38, 39, 41 and 52-55 in their current form are allowable under 35 U.S.C. 103(a) in view of Ginter et al. and plx, for at least the reasons set forth below.

As has been previously stipulated in at least one of the previous Office actions (*see, e.g.*, lines 4-5 of page 17 of the Office action mailed on August 1, 2005), Ginter et al. fails to disclose the transfer of a patent asset as required by claim 35 or a patent as

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required by claim 52. Further, the Applicant is unable to find any disclosure within Ginter et al. regarding the receiving of any of the various types of "first information" identified in claims 35 and 53. Nor is the Applicant able to find any suggestion within Ginter et al. that the teachings within that reference be modified to apply to patent assets. As has been argued previously by the Applicant, Ginter et al. relates fundamentally to the secure transfer of "electronic content" that is susceptible to unauthorized copying, and thus focuses upon systems that provide for the secure transfer of copyrighted material or proprietary (e.g., financial) information rather than patent assets (see, e.g., col. 2, lines 19 et seq.). Thus, it appears to the Applicant that any possible rejection of the claims 35, 36, 38, 39, 41 and 52-55 under 35 U.S.C. 103(a) in view of Ginter et al. necessarily relies upon the combining of Ginter et al. with plx.

Yet, as the Applicant explained to the Examiner in the June 5th Examiner's Interview, Ginter et al. and plx are not properly combinable to arrive at the Applicant's invention. To begin with, the Applicant respectfully repeats the arguments that were advanced in the January 3rd Amendment. In particular, the Applicant submits that it would not have been obvious to one of ordinary skill in the art to combine Ginter et al. with plx to arrive at the Applicant's invention insofar as Ginter et al. and plx apparently fail to provide any suggestion for their combination. Further, as was discussed to some extent in the Examiner's Interview, it also would not have been obvious to one of ordinary skill in the art to combine Ginter et al. with plx or to modify the disclosures in those references to arrive at the Applicant's invention because each of Ginter et al. and plx relates to a different type of business organization with a different manner of operation than that which is the subject of the Applicant's claimed invention.

As is addressed in the present Application (see, e.g., pages 3-4), plx concerns an intellectual property exchange, something that the Applicant's claimed invention is intended to improve upon and possibly interact with (see, e.g., FIG. 1 of the Application). Such an exchange does not buy, sell, license, or otherwise obtain any ownership/possessory interest in any assets being transferred, but rather merely provides a market or forum for facilitating such transfers. Further, while Ginter et al. discloses an intermediary labeled a "VDE rights distributor 106" in FIG. 2, as best as the Applicant can determine, such a distributor does not actually buy, sell, license, or otherwise obtain

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any ownership/possessory interest in any assets being transferred. Rather, it appears to the Applicant that such a distributor instead acts merely as an agent or broker that helps to facilitate and govern/restrict the transmission of content (see, e.g., col. 6, lines 23-28 of Ginter et al.).

The type of business to which the Applicant's claimed invention relates is fundamentally different from the above-mentioned businesses that appear to be disclosed by Ginter et al. and plx. In contrast to the businesses of Ginter et al. and plx, the Applicant's claimed invention relates to a "first entity" (referred to as an "intellectual property investment bank" in the Specification) that buys or sells assets such as patents or otherwise takes an ownership/possessory interest in those assets (e.g., licenses those assets). Upon buying or licensing assets from certain parties, this business is then able to sell or license (e.g., sublicense) those assets to other parties. The fundamental differences between the type of business that is the subject of the Applicant's claimed invention and the types of businesses shown in Ginter et al. and plx are highlighted in Exhibit A attached hereto, which is a chart showing a range of different possible business entities and manners of operation of those business entities, and which is being submitted per a request of the Examiner made during the Examiner's Interview.

As shown in Exhibit A, the Applicant's claimed invention relates to a business that provides "patent underwriting" services, which are described to the right of a middle line shown in the chart. As shown, such a business buys, sells and/or licenses patent assets. The business receives compensation when the business sells or licenses patent assets to others, for example, in the form of royalty payments from licensees. In contrast, brokers and exchanges such as those shown in Ginter et al. and plx, respectively, perform services that can be classified as "patent brokering" services, as are shown in Exhibit A to the left of the middle line of the chart. Rather than taking an ownership/possessory interest in the assets being transferred, and rather than being paid in the form of royalties (or simply being paid for the assets by buyers of the assets upon the sale of those assets), these broker/exchange businesses merely are paid in the form of fixed fees or commissions. The Specification of the present Application explains in significant detail the disadvantages that these types of broker/exchange businesses face and why the type

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of business that is subject of the Applicant's invention is comparatively advantageous (see, e.g., pages 1-13 of the Specification).¹

The Applicant respectfully submits that the above-described differences between the businesses disclosed in Ginter et al. and plx and the business that is the subject of the Applicant's claimed invention are of key significance. Because neither Ginter et al. nor plx concerns the same type of business that is the subject of the Applicant's claimed invention, it would not have been obvious to one of ordinary skill in the art to combine and/or modify the references to arrive at the Applicant's invention. Indeed, even if combined, the two references would not result in the Applicant's claimed invention.² To further clarify and accentuate the differences between the Applicant's claimed invention and plx, the Applicant has amended claim 35 and included similar language in claim 52 to specify additionally that it is the first party (e.g., the party corresponding to an intellectual property investment bank) that provides the proposed agreement onto the internet. These amendments thus further clarify that the first party is itself buying, selling or otherwise transferring interests in the assets in relation to a second party, in a manner that need not involve any broker or exchange.

For at least these reasons, therefore, the Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to combine Ginter et al. and plx to arrive at the Applicant's invention as recited in claims 35, 36, 38, 39, 41 and 52-55, and consequently that independent claim 35, claims 36, 38, 39 and 41 depending

¹ Although the above discussion lumps brokers and exchanges together in an effort to highlight the differences between such businesses and the business that is the subject of the Applicant's claimed invention, this is not to say that brokers and exchanges themselves are identical. Indeed, while an exchange offers the particular service of providing a market or forum for facilitating the transfer of assets among many parties, a broker more typically operates as an intermediary that more actively promotes transactions between more limited numbers of parties.

² Further, given the major differences between exchanges/brokers and the type of business that is the subject of the Applicant's invention, as well as the differences between exchanges and brokers mentioned in the previous footnote, the Applicant further submits that it would not have been obvious to combine Ginter et al. with plx even in the event that the Applicant's understanding of Ginter et al. is mistaken and the "VDE rights distributor" disclosed in Ginter et al. actually does serve to buy, sell, license, and/or otherwise take ownership/possessory interests in assets. That is, even if Ginter et al. is understood to disclose a business like that which is the subject of the Applicant's invention, in such case it nevertheless would not have been obvious to one of ordinary skill in the art to combine Ginter et al. with plx to arrive at the Applicant's claimed invention since the two references then would concern two different types of businesses.

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from claim 35, dependent claim 52, and claims 53-55 depending from claim 52, are all allowable under 35 U.S.C. 103(a) in view of the combination of Ginter et al. and plx.

Rejections Under 35 U.S.C. 103(a) in View of Ginter et al.

Previously pending independent claim 24, as well as previously pending dependent claims 25-34 have been cancelled. At the same time, the Applicant has presented new independent claims 44 and 56 that, as described above, are largely based upon cancelled claim 24. Also, the Applicant has introduced new dependent claims 45-51 and 57-58 that depend from these new independent claims (in addition to dependent claims 52-55 discussed above). Although new independent claims 44 and 56 are largely based upon cancelled claim 24, claims 44 and 56 differ from claim 24 in some notable aspects. Consequently, for at least the reasons set forth below, the Applicant respectfully submits that new independent claims 44 and 56 as well as each of dependent claims 45-51 and 57-58 are allowable under 35 U.S.C. 103(a) in view of Ginter et al.

As was briefly discussed in the Examiner's Interview and set forth in the Applicant's January 3rd Amendment, the Applicant's invention differs from Ginter et al. in that, as best as the Applicant is able to determine, Ginter et al. lacks any discussion of a multi-step, internet-based method that includes a step in which received information of a first type concerning the nature of an intellectual property asset is employed to make a determination regarding the availability or desirability of the intellectual property asset. In particular, the Applicant is unable to find such discussion within columns 269-272 of Ginter et al.

At the same time, the Applicant understands the Examiner to have advanced the view that merely a selection of a bid price could conceivably be viewed as constituting processing that would relate to availability or desirability of an intellectual property asset. While the Applicant does not necessarily agree with this view, to address the Examiner's concern and facilitate advancement of the prosecution of the present Application, new claims 44 and 56 have been amended to more clearly describe the processing that occurs. More particularly, claim 44 now specifies that the processing performed in response to the first information involves evaluation, and also that the processing involves other than merely the selection of a price (it should be understood that, in certain embodiments, the

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evaluation could include the selection of a price but, if this was the case, then the evaluation would not be limited to merely such selection of a price). Further, claim 56 now specifies that valuation analysis occurs in response to the receipt of the first information. The Applicant is unable to find any discussion within Ginter et al. of a process involving these activities.

For at least these reasons, therefore, the Applicant submits that new independent claims 44 and 56, as well as all of claims 45-51 and 57-58 depending therefrom, are allowable under 35 U.S.C. 103(a) in view of Ginter et al.

Additional Comments Regarding Dependent Claims

The Applicant also wishes to direct the Examiner's attention to amended claim 38 and new claims 45-48, 50 and 57, which further describe various types of evaluation or valuation analysis that can be performed by various embodiments of the present invention. As was further discussed in the Examiner's Interview, the Applicant has been unable to find in Ginter et al. any discussion of these particular types of evaluation or valuation analysis being performed. The Examiner will note that, in comparison with at least some other previously-pending claims, the term "status" has now been clarified in these claims to refer to specific types of status inquiries such as ownership status or validity status. Also, the term "market" has been more specifically referred to as a market for products covered by the intellectual property asset rather than merely any market.

The Applicant in particular submits that these dependent claims are allowable notwithstanding the comments found on page 11 of the April 6th Office action relating to cancelled claim 25. For example, the Applicant respectfully submits that, as best as the Applicant can determine, col. 169, lines 27-40 of Ginter et al. fails to disclose the types of status evaluations that are now recited in several of pending claims 38, 45-48, 50 and 57. Likewise, the Applicant also submits that col. 8, lines 20-36, col. 308, lines 36-61 and col. 36, lines 10-43 of Ginter et al. do not provide disclosure concerning analyzing a product covered by an intellectual property asset or a market for products covered by an intellectual property asset as recited in several of pending claims 38, 45-48, 50 and 57. The Applicant further notes that, on page 11 of the April 6th Office action, no citations to

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Ginter et al. were provided with respect to several of the limitations that continue to be recited in several of the pending claims 38, 45-48, 50 and 57, for example, evaluation or analysis of technological scope of an asset or regarding past inquiries concerning an asset.

In view of these comments, the Applicant again respectfully requests allowance of these dependent claims.

* * *

In view of the above Amendments and Remarks, the Applicant respectfully requests reconsideration and allowance of the present Application. The Applicant also respectfully submits that no fees are due in connection with the submission of this Amendment, particularly since the total number of claims and total number of independent claims pending in the Application have not changed. Again, as discussed above, if further discussion with the Examiner would be helpful to further the prosecution of this Application, the Applicant requests that the Examiner contact the Applicant by way of telephone at the number listed below.

Respectfully,


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EXHIBIT A

Spectrum of Patentbank Services

